

REMARKS

I. Status of the Claims

Claims 1-31 are pending in this application. Claims 1, 27, 28, and 30 have been amended herein. In particular, these independent claims have been amended to define the composition recited therein as a mascara composition that withstands rubbing under dry or wet conditions. Support for this amendment can be found in the specification on pages 1-2 and comparative Examples 2-5. Thus, no new matter has been added by this amendment.

II. Rejections under 35 U.S.C. 102(e)

The Examiner has rejected as anticipated under 35 U.S.C. 102(e) claims 1-14 and 21-31 over U.S. Patent No. 6,361,782 to Chevalier ("the '782 patent"), claims 1-16 and 21-31 over U.S. Patent No. 5,851,517 to Mougín ("the '517 patent"), and claims 1-17 and 21-31 over U.S. Patent No. 5,945,095 to Mougín et al. ("the '095 patent").

Applicants respectfully traverse these three anticipation rejections for at least the reason that none of the three references teach each and every element of the independent claims. For example, the '782 patent does not teach a mascara. Rather, this reference teaches an "anhydrous composition for the skin" for camouflaging marks, dyschromia and couperose on the skin. (see, e.g., Abstract; claim 1; and col. 3, lines 53-54). Accordingly, the anticipation rejection based on the '782 patent is improper and should be withdrawn.

Similarly, both the '095 and '517 patents are silent with respect to the ability to withstand rubbing under dry or wet conditions. Thus, as with the '782 patent, the anticipation rejection based on the '095 and '517 patents are improper and should be withdrawn.

In addition, while the Examiner admits that none of the three references applied under 102(e) teach a composition having the claimed viscosity values, she proffers the same flawed rationale as the basis for the rejection over each of the three references. In particular, the Examiner asserts that the claimed viscosity value is inherent in each of the references because the compositions of the '782, '517 and '095 patents "involve[] the same polymers, stabilizers, additives, solvents, etc., and in the same percentages and hence viscosity is inherent." Office Action at pages 3, 4, and 5, respectively. But in making this argument, the Examiner has admitted that the prior art compositions do not necessarily and inevitably exhibit the claimed viscosity properties because such properties require a selection of parameters neither taught nor suggested in the prior art.

Applicants respectfully disagree and challenge the allegation that the claimed viscosity range is "the same," as the three references as applied under 102(e) merely because some of its components might be the same. The Federal Circuit has explained that "[i]nherency . . . may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *Continental Can Co. USA, Inc. v. Monsanto Co.*, 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991); M.P.E.P. § 2112 ("[t]he fact that a certain result or characteristic may occur or be

present in the prior art is not sufficient to establish the inherency of that result or characteristic.”) (emphasis added).

This is true even if there is a disclosure of a family of compounds, some of whose members meet that limitation. For example, in *Akzo N.V. v. U.S. Int’l Trade Comm.*, the Federal Circuit affirmed a finding of no inherency from the mere disclosure of a compound. 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986). The claim-at-issue in *Akzo* recited a method of manufacturing aramid fibers using 98% concentrated sulfuric acid. *Id.* The cited reference taught each element of the claim, including the use of sulfuric acid; however, the reference did not expressly teach the use of 98% concentrated sulfuric acid. *Id.* The Federal Circuit affirmed the Commission’s finding “that concentrated sulfuric acid is not inherently 98% sulfuric acid to one skilled in the art.” *Id.* (emphasis in original). Even though the term “sulfuric acid” encompasses “98% concentrated sulfuric acid,” that is only a mere probability and not an inherent disclosure.

Similarly, in *Mehl/Biophile Int’l Corp. v. Milgraum*, the Federal Circuit reversed a finding of inherency with respect to a process. 52 U.S.P.Q.2d 1303, 1306 (Fed. Cir. 1999). The claim-at-issue recited a method of hair depilation comprising a series of steps, including “aligning a laser light applicator substantially vertically over a hair follicle opening.” *Id.* at 1305. The cited reference was a manual for the laser, explaining its use for removing tattoos. *Id.* at 1304. The court rejected Milgraum’s argument that a vertical alignment of the laser was inherent to the disclosure, saying “the possibility of such an alignment does not legally suffice to show anticipation . . . Occasional results are not inherent.” *Id.* at 1306 (emphasis added). Hence, even though the laser is

clearly either aligned or not aligned with the hair follicle, the mere possibility that it could be is not enough to apply the doctrine of inherency.

In *Ex Parte Viscardi*, the Board reversed an Examiner's finding of inherency with respect to an "effective amount" limitation. 136 U.S.P.Q. 382, 383 (Bd. Pat. App. & Int. 1963). The claims at issue were directed to a method of removing static electricity by the application of freshly evolved carbon dioxide in sufficient concentration to remove the static electricity. *Id.* The Board concluded that while the commercial gas tanks of the prior art reference (Catlin) would initially provide freshly-evolved carbon dioxide:

in the absence of appreciation by Catlin of the fact that carbon dioxide will remove a charge of static electricity, there is no reason why. . . one skilled in the art following his teaching, should inherently adjust the concentration of carbon dioxide for the removal of the complete static charge. In short, the manipulative steps of this group of claims do not inherently result from the disclosure of the basic reference.

Id. Consequently, *the disclosure of a compound without more is not an inherent disclosure with respect to an effective amount, only a mere possibility.*

In view of the foregoing, it is clear that the three references applied by the Examiner do not expressly or inherently teach the claimed invention. In particular, neither the '782 nor the '517 patent teach a mascara composition. To the extent that the '095 teaches a mascara composition, it, like the other two references, clearly do not inherently teach the claimed viscosity values. Rather, in order to support the assertion of inherency, the Examiner must find and articulate some justification in the prior art showing that the compounds of the three references would *always* yield a composition with the viscosity properties of the claimed compound. The Examiner has not made

that showing, and hence, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. 102(e).

III. Rejections under 35 U.S.C. 103(a)

The Examiner has rejected as obvious under 35 U.S.C. 103(a) claims 17-20 over the '517 reference and claims 18-20 over the '095 reference. The Examiner argues that "it would have been obvious . . . to choose the claimed fatty esters, alcohol, and specific silicone oils in preparing the composition [of the present application] because [both '517 and '095 teach] all of the above fatty esters as equivalent in their solubilizing efficacy and compatibility with the surface-stabilized polymer." Office Action at 5-6.

In light of the amendments made herein, Applicants respectfully traverse this rejection. To establish a *prima facie* case of obviousness, three basic criteria must be met, including that the prior art references must teach or suggest all the claimed limitations, and there must be reasonable expectation of success to achieve the claimed invention. See *M.P.E.P.* § 2143. In the present case, at least these criteria have not been met.

Applicants respectfully submit that the Office has not met its burden of establishing a *prima facie* case of obviousness because neither the '517 nor '095 reference teach the ability to withstand rubbing under dry or wet conditions, as is presently claimed. Thus, all the claimed limitations have not been taught in the prior art. Additionally, one skilled in the art could not have a reasonable expectation of success in achieving the claimed invention from starting with the references cited because the references do not teach the claimed ability to withstand rubbing under dry or wet

conditions, as is presently claimed. Thus, for at least these two reasons, Applicants request removal of the obviousness rejections over the references of record.

IV. Double Patenting Rejections

The Examiner has maintained the obviousness-type double patenting rejection of claims 1-31 over claims 1-47 of the '095 patent and claims 1-21 of the '782 patent. In maintaining this rejection, the Examiner states that "both the references teach the same surface-stabilized polymers, fatty phase containing the claimed oils, esters, and other volatile oils for preparing a dispersion comprising surface stabilized polymer." Office Action at 7. Therefore, the Examiner concludes, "the percentage of polymer and viscosity claimed are inherent to the compositions of '095 and '782."

With regard to the double patenting rejection over claims 1-21 of the '782 patent, this rejection has been rendered moot by the terminal disclaimer concurrently filed herewith.

With regard to the double patenting rejection over claims 1-47 of the '095 patent, Applicants traverse this rejection because the Examiner cannot show the claimed percentage of polymer is inherent since this clearly changes with the desired form of the final product. Support for this position is found in the claims of the '095 used to reject the pending claims, which recite compositions in a form ranging from a liquid to a powder to a stick. Indeed, the claimed mascara of the '095 patent can be in the form of a solid, paste or oily gel, which all clearly cannot have, and thus none inherently can have, the claimed viscosity value. For at least these reasons, the percentage of polymer is not inherent since it depends on the form that is desired, from solid to pasty

to gel. For the same reasons, the ability to withstand rubbing under dry or wet conditions is not obvious, and certainly not inherent in the claims of the '095 patent. Rather, this property is a function of elements neither taught nor suggested in the claims of the '095 patent.

Accordingly, this rejection is improper and should be withdrawn.

V. Conclusion

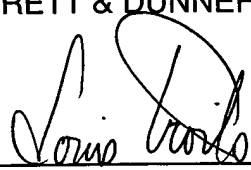
In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application, and the timely allowance of the pending claims. If the Examiner believes a telephone conference could be useful in resolving any outstanding issue, the Examiner is invited to contact Applicants' undersigned counsel at 202-408-6020.

If there is any fee missing in connection with the filing of this response, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

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